

45. [Amended] Recombinant host cells according to claim 44
wherein said genetically diverse population is derived from [in vitro] *in vitro*
mutagenesis of nucleic acid encoding a specific binding pair member.

II. REMARKS

The specification has been amended to reflect the priority and status of the parent applications as requested by the Examiner. Claim 45 has been amended to clearly indicate that *in vitro* should be underlined or italicized in the published patent. In addition, claims 41 has been amended in response to the Examiner's indefiniteness rejections.

III. PATENTABILITY ARGUMENTS

A. The Rejection of Claims 44-53 Under 35 USC §112, Second Paragraph Should be Withdrawn

Claims 41-53 stand rejected under 35 USC §112, second paragraph, as allegedly being indefinite. The Applicants respectfully disagree.

35 USC §112 requires that the claims must set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Furthermore, definiteness of claim language must be analyzed, not in a vacuum, but in light of: (a) the content of the particular application disclosure; (b) the teachings of the prior art; and (c) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

The Examiner asserts that claim 44 is vague and indefinite by reciting "host cells harboring a library of nucleic acids" because it is not clear what is meant by "harboring" and by "host cells harboring a library of nucleic acids." Applicants respectfully disagree. The phrase "host cells harboring a library of nucleic acids" is

well known in the art and the scope of a claim including such a phrase would be clearly set out to one of ordinary skill in the art.

The Examiner also asserts that claim 44 is vague and indefinite by reciting "type of member of a specific binding pair" because it is not clear what Applicant means by "type of member." In response, Applicants have deleted "type of" from claim 44. Because the specification teaches that a specific binding pair is "a pair of molecules (each being a member of a specific binding pair)", see page 27, lines 22-24 of the specification, amended claim 44 sets out and circumscribes the subject matter with a reasonable degree of clarity and particularity.

The Examiner further asserts that claim 44 is vague and indefinite by reciting "in functional form" because it is not clear what function the Applicants are describing. Applicants respectfully disagree. As described on page 30, lines 17-26, as applied to specific binding pair members, **functional** means that the specific binding pair member is presented in a folded form comprising a binding domain for its complementary specific binding pair member such that it maintains its ability to **bind** its complementary specific binding pair member. The relevant function is the folded domain able to bind the complementary specific binding pair member. Therefore, read in light of such a disclosure in the application, the recitation of "in functional form" is not vague and indefinite and, in fact, provides the required of clarity and particularity.

The Examiner also asserts that claim 44 is vague and indefinite by reciting "said specific binding pair members are displayed on the surface of bacteriophage particles in functional form comprising a binding domain for a complementary specific binding pair member and genetic material of each particle

displaying a specific binding pair member encodes the associated displayed specific binding pair member." In response, Applicants have amended claim 44 to more clearly describe that a displayed specific binding pair members comprises a binding domain for its complementary specific binding pair member.

The Examiner also asserts that claim 44 is vague and indefinite by reciting "and genetic material of each particle displaying a specific binding pair member encodes the associated displayed specific binding pair member" because it is not clear what the Applicants means by "the associated displayed specific binding pair member." In response, Applicants have amended claim 44 to more clearly describe that the genetic material of each particle displaying a specific binding pair member encodes its associated displayed specific binding pair member.

The Examiner also asserts that claim 44 is vague and indefinite by reciting "which uses a helper phage for packaging into said particles." In response, Applicants have amended claim 44 to more clearly describe the role of the helper phage.

Finally, the Examiner asserts that claim 44 is vague and indefinite by reciting "a said fusion." The Examiner has requested that Applicants amend claim 44 to recite "said fusion." Applicants respectfully submit that "a said fusion" is proper in this instance. Claim 44 refers to recombinant host cells and libraries. However, where "a said fusion" is used in claim 44, it refers to an individual particle that has a fusion as opposed to recombinant host cells expressing fusions. Therefore, "a said fusion" is not vague or indefinite and describes the claimed subject matter with clarity and particularity.

B. The Rejection Based on Nonstatutory
Double Patenting Should be Withdrawn

Claims 44-53 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4, 7, 21 and 29 of U.S. Patent No. 5,969,108. Without in any way acknowledging agreement with the Examiner's statement with respect to the claims of the present application, and merely to expedite the allowance of the present application, Applicants are submitting a terminal disclaimer herewith. Therefore, the rejection is moot and should be withdrawn.

IV. CONCLUSION

In view of the foregoing amendments and remarks, the Applicants respectfully submit that the claims are now in condition for allowance and early notification thereof is respectfully requested. Should the Examiner wish to discuss any further matter of form or substance, she is encouraged to contact the undersigned attorney at the number listed below.

Respectfully submitted,

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February 25, 2000